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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,993	08/15/2005	Karel Dolezal	J507-005 US	8995
21706 7590 05/22/2009 NOTARO & MICHALOS P.C. 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100				
EXAMINER				
MCINTOSH III, TRAVIS C				
ART UNIT		PAPER NUMBER		
1623				
MAIL DATE		DELIVERY MODE		
05/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/540,993

**Applicant(s)**

DOLEZAL ET AL.

**Examiner**

TRAVISS C. MCINTOSH III

**Art Unit**

1623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2, 15-17 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

The Amendment filed 2/11/2009 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claim 2 has been amended.

Claims 1, 3-14, and 18-21 stand as being canceled.

Claim 22 has been added.

Remarks drawn to rejections of Office Action mailed 8/7/08 include:

102(b) rejection: which has been overcome in part by applicant's amendments as applicants have deleted some of the species which anticipated the genus claimed. However, certain species are still anticipated as set forth below.

### ***Election/Restrictions***

Newly submitted claim 22, directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for using the product can be practiced with a materially different product, such as using ATP to treat cancer.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 22 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

An action on the merits of claims 2 and 15-17 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

Claims 2 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Dietmann et al. (US 3,506,653).

Dietmann discloses compound L in column 6 which is seen to be 6-(2-methoxybenzylamino)purine riboside. Dietmann et al. also discloses compositions comprising the same with polyethylene oxide and glucose (see column 6, lines 1-13) wherein the intended use is not seen to make patentable the compositions claimed as the prior art's compositions could have functioned in the same way as the instant compositions, as they contain the same amount of the same agents, and thus are seen to be the same. It is noted that the examiner noted in the previous office action that this compound anticipated the current claims. While the examiner has made an effort to indicate all of the species which are contained in the reference and anticipate the instant claims, it is noted that "A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus." The species in that case will anticipate the genus. In re Slayter, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietmann et al. (US 3,506,653).

Dietmann et al. discloses the compound (6-(3,4-dichlorobenzylamino)purine riboside on column 6. Dietmann et al. also discloses compositions comprising the same with polyethylene oxide and glucose (see column 6, lines 1-13) wherein the intended use is not seen to make patentable the compositions claimed as the prior art's compositions could have functioned in the same way as the instant compositions, as they contain the same amount of the same (or obvious) agents, and thus are seen to be the same.

While applicants have removed the species which were specifically disclosed in Dietmann by amendment, there are still species which are obvious variants. For example, Dietmann disclosed and applicants canceled (6-(3,4-dichlorobenzylamino)purine riboside, however, compounds 6-(3,5-dichlorobenzylamino)purine riboside, 6-(2,3-dichlorobenzylamino)purine riboside, 6-(2,4-dichlorobenzylamino)purine riboside, 6-(2,5-dichlorobenzylamino)purine riboside, 6-(2,6-dichlorobenzylamino)purine riboside are all considered obvious variants, as it is well settled that compounds that differ only as positional isomers are not deemed patentably distinct absent evidence of superior, unexpected results. See *In re Crounse* 150 USPQ 554; *Ex parte Engelhardt* 208 USPQ 343 regarding position isomerism.

Dietmann also discloses 6-(3-trifluoromethyl)benzylamino)purine riboside, which was canceled by applicants. However, 6-(4-trifluoromethyl)benzylamino)purine riboside is deemed obvious as it is a positional isomer as set forth *supra*.

Dietmann also discloses 6-(3,5-dimethoxybenzylamino)purine riboside, which was canceled by applicants. However, 6-(2,3-dimethoxybenzylamino)purine riboside; 6-(2,4-

dimethoxybenzylamino)purine riboside; 6-(2,5-dimethoxybenzylamino)purine riboside; and 6-(2,6-dimethoxybenzylamino)purine riboside are deemed obvious as positional isomers as set forth supra.

Dietmann also discloses 6-(4-bromobenzylamino)purine riboside, which was canceled by applicants. However, 6-(3-bromobenzylamino)purine riboside is deemed obvious as a positional isomer as set forth supra.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRAVIS C. MCINTOSH III whose telephone number is (571)272-0657. The examiner can normally be reached on M-F 9:30-6:00.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traviss C McIntosh III/  
Primary Examiner, Art Unit 1623  
May 11, 2009